

Remarks

Amendments to the claims

Claim 5 has been amended to more clearly recite that "the light source" comprises a stationary light source. Claim 6 has been amended to be consistent with amended claim 5, from which claim 6 depends.

Rejection of Claims under 35 U.S.C. § 112

The Examiner has stated that, "Claims 1, 13 and 21 and all dependent claims are rejected under 35 U.S.C. second paragraph. The specification discloses two different light sources (stationary and moveable). The light sources claimed as part of scan window illumination and the scanning light source are not clearly distinguishable in the claims. As an example please refer to claims 1-3 and claim 5."

The Applicants respectfully traverse the Examiner's rejection, and contend that claims 1-27 are, in fact, definite. Specifically:

Claims 1-12:

With respect to independent claim 1, that claim recites that the “scan window apparatus” comprises a “scan window illumination device” configured to illuminate the selected scan window”. Clearly, no limitations on the “scan window illumination device” are set forth in claim 1, other than that it “illuminate the selected scan window”. The Applicants contend that the recited “scan window illumination device” of claim 1, in combination with the other recited elements and limitations of claim 1, define novel, non-obvious subject matter. Further, as will be described more fully below, the full scope of the “scan window illumination device” of claim 1 is well supported by the specification and drawings. Accordingly, the Applicants contend that no additional limitations regarding the “scan window illumination device” need to be set forth in claim 1 in order to render the claim definite. As set forth in MPEP

1 2173.04, "Breadth of a claim is not to be equated with indefiniteness." That is, the
2 breadth alone of claim 1 should not be used as a basis for rejecting the claim under
3 35 USC § 112 ¶.

4 While certain of the claims (2-12) that depend from claim 1 set forth further
5 limitations on the "scan window illumination device", the Applicants contend that
6 there is nothing within these dependent claims that is inconsistent with (1) claim 1,
7 (2) the specification, (3) and/or drawings. That is, none of dependent claims 2-12
8 are indefinite under 37 USC § 112 ¶ 2. For example, as recited in claim 2, "the scan
9 window illumination device comprises a light source positioned to direct light to the
10 second side of the platen", which is consistent with Figs. 6, 7 and 9 (and the
11 accompanying description). In claim 3, "the light source" (of claim 2) is described as
12 "compris[ing] a stationary light source", which is consistent with Figs. 6 and 9 (and
13 the accompanying description). In claim 5 (as amended), "the light source" (of claim
14 2) is described as "compris[ing] a moveable light source", which is consistent with
15 Fig. 7 (and the accompanying description). In claim 7, the "scan window illumination
16 device" is recited as "compris[ing] a light source located in each of the position
17 markers", which is consistent with Figs. 4 and 5 (and the accompanying description).
18 In short, the "scan window illumination device" of claim 1 can be a separate light
19 source (Figs. 4-6 and 9, and accompanying description), the same light source as
20 the scanning light (Fig. 7, and accompanying description), a stationary light source
21 (Figs. 6 and 9, and accompanying description), a moveable light source (Fig. 7, and
22 accompanying description), etc. – i.e., there are no limitations on the "scan window
23 illumination device" recited in claim 1, other than that it "illuminate the selected scan
24 window"! The mere fact that certain of the dependent claims (2-12) set forth further
25 limitations regarding the "scan window illumination device" does not render those
claims indefinite in light of the base claim (claim 1), so long as the limitations in the

1 dependent claims do not obviate the limitation in claim 1 that the "scan window
2 illumination device illuminate the selected scan window", *which they do not*.

3 Further, the fact that certain dependent claims may be inconsistent with one
4 another does not render those claims indefinite, so long as they do not depend from
5 one another. Nothing in 35 U.S.C. § 112 paragraph 3 requires that dependent
6 claims be consistent with one another.

7 Accordingly, for at least the above reasons, the Applicants contend that
8 claims 1-12 are, in fact, definite. The Applicants therefore respectfully request that
9 the rejection of claims 1-12 under 35 U.S.C. § 112 paragraph 2 be removed and that
10 the claims examined on their merits.

11

12 Claims 13-20 and 21-27:

13 With respect to independent claim 13, the Applicants contend claim 13 is not
14 indefinite, and that none of claims 14-20, which depend from claim 13, are
15 inconsistent with claim 13 (and thus indefinite). Further, with respect to independent
16 claim 21, the Applicants contend claim 21 is not indefinite, and that none of claims
17 22-27, which depend from claim 21, are inconsistent with claim 21 (and thus
18 indefinite).

19 Moreover, the Examiner has not given any specific reasons for rejecting
20 claims 13-27, other than to say that they are "rejected under 35 U.S.C. second
21 paragraph". (See page 2 of Office action, bottom of page.) Such a rejection is in
22 complete contravention to the requirements of 35 U.S.C. § 132(a), which states,
23 "Whenever, on examination, any claim for a patent is rejected ..., the Director shall
24 notify the applicant thereof, stating the reasons for such rejection ... together with
25 such information and references as may be useful in judging of the propriety of
continuing the prosecution of his application ..." (Emphasis added.) In this case,
the Examiner has given no "reasons" for the rejection of claims 13-20, and has not

1 provided any "information as may be useful in judging of the propriety of continuing
2 the prosecution of his application", other than to say that the claims are "rejected
3 under 35 U.S.C. second paragraph". Such a statement does not amount to a
4 "reason" for the rejection, and does not provide the "information" required by the
5 statute. Further, as set forth in MPEP 707.07(d), "If the claim is rejected ... as
6 indefinite the examiner should point out wherein the indefiniteness resides" In
7 this requirement the rejection of claims 13-27 is completely lacking, as the Examiner
8 has not indicated "wherein the indefiniteness resides" in these claims (13-27).

9 Therefore, in light of the fact that the Examiner has failed to meet the
10 requirements of 35 U.S.C. § 132(a) in rejecting claims 13-27, the Applicants
11 respectfully request that the rejection of claims 13-27 under 35 USC § 112 second
12 paragraph be removed, and that the claims be examined on their merits.

13

14 Summary

15 The Applicants believe that this response constitutes a full and complete
16 response to the Office Action. In view of the foregoing, the Applicants respectfully
17 request reconsideration on the merits of claims 1-27 in favor of timely allowance.

18 The Examiner is respectfully requested to contact the below-signed
19 representative if the Examiner believes this will facilitate prosecution toward
20 allowance of the claims.

21

22 Respectfully submitted,

23

24 Robert Sesek, Christian Struble and
Jackson Michael Dunlap, Applicants

25 Date: April 04, 2005

By John S. Reid
John S. Reid
Attorney and Agent for Applicants
Reg. No. 36,369
Phone: (509) 534-5789

S/N: 09/938,893
Case 10010609-1
Amendment "A"